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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 11

Application Number: 09/272,845
Filing Date: March 19, 1999
Appellant(s): ROLLINS, DOUGLAS L

Fred G. Pruner, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 15, 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-16, 41 and 42 stand or fall together; and claims 17-32,43 and 44 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,974,454	Apfel et al.	10-1999
5,974,474	Furner et al.	10-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 33-40 are rejected under 35 U.S.C. 102 (e). This rejection is set forth in prior Office Action, Paper No. 6.

Claims 1-32, and 41-44 are rejected under 35 U.S.C. 103 (a). This rejection is set forth in prior Office Action, Paper No. 6.

(11) Response to Argument

(A) In reference to the 35 USC 103(a) rejection as noted above in item 10, Appellant argues in page 9, 1st paragraph of Appeal brief that, Furner neither teaches nor suggests determining whether a second version of a driver is more current than a first version of a driver. Examiner is confused with as to what Appellant is, basing his argument, as (1) Appellant argues for such subject matters not relied upon by Examiner, i.e. in (Paper No.6, page 5) per item 10 (35 U.S.C. 103 (a)) above, Furner (secondary reference) is being relied upon for such limitations " software module being associated with circuitry " only, (see Furner, 4: 62-67 & 5:55-61), and not for determining whether a second version of a driver is more current than a first version of a driver, as Appellant argues for as noted above, whereas Apfel (primary reference), instead of Furner is infact being relied upon for such a "determining" limitation (Apfel, 11:62-67, as noted in Paper No. 6, page 5). And (2) furthermore, even arguably, Furner is infact concerned with whether a second version of a driver is more current than a first version of a driver (software). For example (Furner, 1: 45-55), where Furner discusses offering more current devices/drivers or revision for devices/drivers to particular device models as it is made available over time. And (Furner, 4: 62-67), where Furner provides "means for determining a relative capability of each of the plurality of drivers

(software) to support the hardware instance (compatible and/or associated), and means for selecting an optimal driver having a capability to support the hardware instance..." (Emphasis added). Although Furner is primarily concerned with hardware identification and configuration and selecting the most optimal device driver (software), it is well known in the art for hardware to be operative utilizing associative device drivers (software) for its efficient operation, and revising the hardware would also be directly associated with revising the device driver. This is also noted in Furner at col. 1 line 50-60.

(B) Appellant in page 10 also argues that Apfel does not disclose determining whether a second version of a software module is compatible with circuitry that is associated with the software module. Contrary to this notion, as examiner pointed out in Paper No. 6, page 5, Apfel does clearly teach this limitation (Apfel, 7:15-25). Indeed Apfel is concerned with a system for updating and installing components over a network of servers depending on if upgrade (software) is compatible with computer (circuitry). For example (7:16-20), Apfel states, " For example, even if an upgrade is available, it should not be downloaded if the computer 20, already has the upgrade (same as second version) or if the upgrade is somehow *incompatible* with computer 20 (circuitry) " (Emphasis Added).

(C) With regards to Appellant's assertion, in page 10 last paragraph, that there is no motivation, or suggestion to combine Apfel and Furner. Examiner disagrees, as pointed out on the Advisory Action mailed on June 12, 2002, which is again maintained. And as noted above, Apfel is concerned with a system for determining whether a

second version of a driver is more current than a first version of a driver, and Furner provides the difference, i.e., software module being associated with circuitry while loading and/or installing a particular driver (software) that serves, associates, or supports a particular hardware device model (Furner, 1: 39-60). Both Apfel and Furner disclose providing more current versions as needed or when available, and thus are analogous art. Therefore, one would be motivated to make that combination to implement such as Appellant's claimed invention.

(D) In reference to the 35 USC 103 rejections of claims 17-32,43, and 44, which are claimed as computer-readable products (program storage devices) versions of the claimed methods discussed above, claims 1-16,41 & 42. Appellant merely rehashes arguments presented in previous claims 1-16,41 & 42 above, in which Examiner already addressed and/or provided with counter arguments. Therefore, those features will not be repeated again but rather the final rejection in Paper No. 6, will be reproduced below for completeness.

Paper No. 6

DETAILED ACTION

RESPONSE TO AMENDMENT

This Office Action is the response to the communication received on January 15, 2002Amendment under 37 CFR § 1.111.Reconsideration of the instant application is requested by applicants. All such supporting documentation has been placed of record in the file.Claims 1-44 are pending in this application. The amendment filed is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no

amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Using the date to establish compatibility between second and first programs in claims 41 & 43. Applicant is required to cancel the new matter in the reply of this Office action.

1.

Response to Arguments

Regarding rejection of the claims 1-44 under 35 U.S.C. §103(a) & §102(a): Examiner has evaluated applicant's arguments of January 15th correspondence which has been fully considered is not persuasive to overcome the previous rejection aforementioned, 35 U.S.C.§102(a) & § 103(a) per, pages 2-7 with previous cited references *Apfel et al.* For purpose of examining claim 38 will be referred to as claim 39. Examiner interprets using the date to establishing compatibility between second and first programs as upgrading depending on later date.

Claim objection

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Claim 39 was misnumbered as 38. Correction is needed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear,

concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 41, & 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification doesn't show using the date to establish compatibility between second and first programs.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims *33-40* are rejected under 35 U.S.C. 102(a) as being anticipated by Apfel et al . US-PAT-NO: 5974454 hereinafter Apfel.

Regarding claims 33 Apfel shows, a computer executed method to update a software module, comprising (fig 4a), identifying a software module (2:62-64) automatically obtaining version information of the software module from a local source (2:62-64,see version of software module on computer), automatically obtaining version information of the software module from a non-local source; [refer to 11:66-67, also see fig 4a, part # 427, *note*: by

definition an upgrade is a more current version of software than the prior version],comparing the version information from the local source with the version information from the non-local source, (11: 62-64, see older than user's version) and automatically retrieving an update module for the software module if the version information from the non-local source is newer than the version information from the local source.(3:25-28)

Regarding claim 34 the method of claim 33, wherein the act of retrieving further comprises updating the software module with the retrieved update module. [abstract, also see fig 4a part # 451].

Regarding claim 35 the method of claim 33, further comprising automatically updating the software module with a local update module obtained from a local media source if the version information from the local source is newer than the version information from the non-local source. [abstract, 11:32-34].

Regarding claim 36 the method of claim 33, wherein the act of obtaining version information from a local source comprises, obtaining version information from a registry file. [fig 4b part#406, also see abstract].

Regarding claim 37 the method of claim 33, obtaining version information from a local source comprises, obtaining version information from a local floppy disk. [see fig1,part # 29, also see 4:25-30,with respect to abstract]

Regarding claim 38 the method of claim 33, wherein the act of obtaining version information from a non-local source comprises, obtaining version information from a website. [also fig2 part #75a, also see 11:20-25]

Regarding claim 39 as interpreted see reasoning in 38.

Regarding claim 40 the method of claim 33, wherein the act of obtaining version information from a non-local source comprises, obtaining version information from dial-in server. [dial-in server is interpreted as a modem, fig 1,part #54.also see 5:13 and 11:32-34].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6,8-22,24-32,41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Apfel et al. US-PAT-NO: 5974454 hereinafter Apfel in view of Furner et al. USPN 5,974,474 hereinafter Furner.

Apfel as modified discloses updating a software module, by identifying a first version of the software module (11: 64-65, see user's version),identifying a second version of the software module, (11: 62-64, see later version) automatically determining whether the second version is more current than the first version (11: 62-64, see older than user's version), and indicating that version of the software module determined to be most current. (11:66-67, also 7:18-20 for compatibility of upgrades). Apfel doesn't expressly disclose software module being associated with circuitry [hardware device as taught in Applicants specification page, 4 lines 21-22]. However, Furner does disclose software module being installed on a computer system and being associated with circuitry of the computer system other wise known as device driver. Therefore, it would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify teachings of Apfel to install device a driver as taught by Furner because, configuring device drivers from remote locations improves ease of modification.

Regarding claims 2,&18 as disclosed in claim 1, further comprising obtaining that version of the software module determined to be the most current version. [Apfel refer to 11:66-67, also see fig 4a, part # 427, *note*: by definition an upgrade is a more current version of software than the prior version]

Regarding claims 3,&19 as disclosed in claim 2, further comprising loading the obtained version of the software module. [Apfel see fig 4b, part # 448, 454 for downloading upgrade and installing upgrade]

Regarding claims 4,&20 as per claim 1, wherein the act of identifying a first version of the software module comprises communicating with a physical device associated with the software module. [Furner *5:30-35*]

Regarding claims 5,&21 as per claim 4, wherein the act of communicating comprises determining an identifier value of the physical device. [Furner 5: 30-40].

Regarding claims 6,&22 as disclosed in claim 5, further comprising determining a subsystem identifier value of the physical device [Furner 5: 30-40].

Regarding claims 8,&24 method of claim 1, wherein the act of identifying a second version of the software module comprises communicating with an update information source.
[Apfel abstract, see transmit query via the Internet to database server, also see item# 433, & 439 from fig 4b].

Regarding claims 9,&25 the method of claim 8, wherein the act of communicating further comprises:

identifying the software module to the update information source;[Apfel 2:62-64].

receiving, from the update information source, an indication of the second version of the software module. [Apfel 2:52-54]

Regarding claims 10, &26 the method of claim 8, wherein the act of communicating comprises communicating by a modem. [Apfel fig 1,part #54.also see 5:13]

Regarding claims 11,&27 the method of claim 8, wherein the act of communicating comprises communicating by a computer network.[Apfel 5:5-10]

*Regarding claims 1*2,&28 the method of claim 8, wherein the act of communicating comprises communicating with a database server device.[Apfel abstract, fig2 Part# 80b]

Regarding claims 13,&29 the method of claim 1, determining comprises comparing at least one characteristic of the first identified first version of the software module with the same characteristic of the second identified first version of the software module. [Apfel *abstract* see date, also see fig 4a part# 406].

Regarding claims 14, &30 the method of claim 1, indicating comprises visually displaying an indication of the software module determined to be the most current version to a user. [Apfel see 10:23-28, also see fig4a part# 409]

Regarding claims 15,&31 the method of claim 2, wherein the act of obtaining comprises retrieving that version of the software module determined to be the most current version from an update source. (Apfel 11:66-67, also 7:18-20 for compatibility of upgrades)

Regarding claims 16,&32 the method of claim 15, wherein the act of retrieving comprises retrieving from an update source that is physically distinct from the location of the first identified version of the software module. [Apfel abstract, see server, also see part# 451 from fig 4b]

Regarding claim 41 (new claim) method of claim 1,wherein determining comprises: determining a date associated with the first version, the date establishing compatibility between second and first. [See abstract, also refer to part #406 from fig 4a].

Regarding 41 according to claim 1, circuitry comprising an add-in card. [hardware device as taught in Applicants specification page, 4 lines 21-22, see Furner 7: 55-57].

Regarding claim 43 (new claim) see reasoning in claim 41.

Regarding claim 44 (new claim) see reasoning in claim 42.

Claims 7,23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Apfel et al .US-PAT-NO: 5974454 hereinafter Apfel as applied in claim 4 in view of of Furner et al. USPN 5,974,474 hereinafter Furner and in further view of admitted prior art.

With regards to claims 7, & 23 Apfel as modified by Furner as applied in claim 4 discloses all the claimed limitations. Apfel as modified by Furner doesn't explicitly disclose determining a basic input-output system version identifier value of the physical device. However, Applicants disclosure admits that determining a basic input-output system version identifier value of the physical device is old and well known [page 1.lines 10-18]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Apfel as modified by Furner and admission to update the BIOS because, obtaining BIOS information during upgrading/updating is a common practice.

2. *This action is made Final.*

Applicant's arguments are not persuasive to overcome 35 U.S.C. § 102(a) or 35 U.S.C. § 103(a) as discussed per, prior art with previous cited reference **Apfel et al.**

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. See MPEP § 706.07 (a).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ck

November 15, 2002

Gregory Morse, SPE A.U. 2122

Tuan Dam, Primary Examiner A.U. 2124